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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,902	01/16/2002	Shunpei Yamazaki	740756-2405	2970
31780	7590	01/04/2005	EXAMINER	
ERIC ROBINSON PMB 955 21010 SOUTHBANK ST. POTOMAC FALLS, VA 20165			POTTER, ROY KARL	
			ART UNIT	PAPER NUMBER
			2822	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,902

Applicant(s)

YAMAZAKI, SHUNPEI

Examiner

Roy K Potter

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Reissue Applications

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue is sought based on the alleged errors of the failure of the Patent and Trademark Office to properly act on the petition to withdraw a Terminal Disclaimer filed under 37 CFR 1.182 or withdrawing the application from issuance under 37 CFR 1.313 either before or after the payment of an issue fee and that this error resulted in the patentee claiming less than the patentee had a right to claim in regards to the term of the patent that issued.

As a general principle, public policy does not favor the restoration to the patent owner of something that has been freely dedicated to the public, particularly where the public interest is not protected in some manner — e.g., intervening rights in the case of a reissue patent. See, e.g., *Altoona Publix Theatres v. American Tri-ErgonCorp.*, 294 U.S.477,24 USPQ 308 (1935).

The Applicant suggests that reissue be used to nullify the Terminal Disclaimer here and points to the decision of the Board of Patent Appeals and Interferences in the reissue examination of RE35,754 to Durckheimer et al. as an example of where a reissue has been used for such a purpose. However, the present application is distinguishable from that case.

Response to Arguments

The Applicant argues that there are five errors upon which the present reissue application is based. All of these relate to the handling of a Petition to Withdraw a Terminal Disclaimer filed in the parent Application.

The question of whether the Terminal Disclaimer was necessary or unnecessary in the parent is not determinative in the present reissue application. The more relevant question is whether a reissue application is the proper method for correcting an error resulting from a Petition to Withdraw a Terminal Disclaimer. Here the alleged error would have been avoided if the Petition had been approved by the Patent Office prior to the patent issuing, or if the patent had been withdrawn from issue either before or after the payment of the issue fee, until the Petition to Withdraw the Terminal Disclaimer was acted upon. None of these occurred.

While it is clear that a Terminal Disclaimer can be withdrawn before the issuance of a Patent, It appears that the Durckheimer decision cited by the precedent value of that decision was intended to be limited to a unique set of facts and circumstances wherein the claims were secured by filing a Terminal Disclaimer and then canceled before the patent was granted. That is not the circumstance in the present case, and the examiner is reluctant to apply the Durckheimer decision to a set of facts and circumstances as different as the present reissue application presents. Here the Terminal Disclaimer was not rendered moot by the canceling of claims, as in Durckheimer.

Without clear direction from either a precedent or the MPEP that indicates that the alleged error is correctable by a reissue, the examiner has no basis for indicating allowability in the present reissue application, as no authority exists to do so.

Conclusion

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy K Potter whose telephone number is 571 272 1842. The examiner can normally be reached on M-F.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Roy K Potter', with a stylized, flowing script.

Roy K Potter
Primary Examiner
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